

In re Application of Anderson
Application No. 10/663,498
Amendment and Response to Office Action
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REMARKS

The Applicant appreciates the Examiner's review of the application and consideration of the amendments presented.

Provisional Election of Claims

The Applicant acknowledges the Examiner's withdrawal of claims 29-33 as being directed to a non-elected invention. The Applicant expressly reserves the right to file one or more divisional or other applications directed toward the invention recited in claims 29-33.

Withdrawal of the *Molee* Rejections

The Applicant notes and acknowledges the withdrawal of the previous rejections based on U.S. Patent 5,829,832 issued to *Molee, et al.*

New Claims

Claims 1-28 are not amended.

The Applicant submits new claims 34-51, which recite an apparatus and method without reference in the independent claims to a container.

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CLAIM REJECTIONS – 35 U.S.C. § 103(a)

A. The Independent Claims Recite Patentable Subject Matter.

Office Action, ¶ 3: The Examiner rejected claims 1, 10-13, 16, and 23-26 under Section 103(a) as being obvious and unpatentable over a new reference, U.S. Patent 6,604,789 issued to *Downing*. This obviousness rejection is based on *Downing* alone.

MPEP § 2142: *Downing* does not teach or suggest all the features of the claimed invention. A *prima facie* case of obviousness requires that the cited prior art reference(s) teach or suggest all the features of the claimed invention. MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.” MPEP § 2142; *In re Geiger*, 815 F.2d 686, 690 (Fed. Cir. 1987).

Downing does not teach or suggest all the features of the claimed invention. For example, among other features, *Downing* does not teach or suggest a writing surface as recited in independent claims 1 and 16. Although the Examiner asserts that “*Downing* teaches writing surface 35,” (Office Action at ¶ 4, p. 2,) the words “writing surface” appear nowhere in the *Downing* reference and the element number 35 is never identified. Figure 3 illustrates a “cover 34” which is not described as a writing surface. Nothing in *Downing* teaches or suggests a writing surface of any kind, anywhere on the structure. *Downing* is not combined with any other reference to support the rejection of claims 1, 10-13, 16, and 23-26.

Because *Downing* does not teach or suggest all the features, the rejection does not meet the initial burden of stating a *prima facie* case of obviousness and it should be withdrawn.

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B. The Dependent Claims Recite Patentable Subject Matter.

The remaining rejections address dependent claims. The independent claims recite patentable subject matter, including features that are not taught or suggested by the cited references. Whether cited alone or in combination with any other reference, *Downing* does not teach or suggest all the features recited in the independent claims. The features recited in the dependent claims are patentable.

C. The Claimed Assembly Includes Structural Limitations That Are Unrelated to Any Particular "Intended Use."

In the Office Action, ¶ 5, the Examiner stated: "Regarding the location of the writing surface, the edge and the open container are not part of the claimed invention. Such language is considered to be intended use only."

The Applicant respectfully disagrees. Claim 1, for example, recites "... a slot positioned and sized ... such that a majority of said writing surface extends beyond said edge when said edge is received within said slot" The position of the writing surface relative to a received edge is determined by the recited structure of the slot. As recited, the slot includes a structural limitation on its position and size relative to the writing surface. The slot structure recited is the same, whether the assembly is used with any type of container, or with no container.

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**D. The New Independent Claims, 34 and 43, Recite Structural
Limitations of a Slot Without Reference to a Received Edge.**

As in claim 1, new claims 34 and 43 recite a slot that includes a structural limitation on its position and size relative to the writing surface.

Claim 34, for example, recites "... a slot ... extending upward from said bottom side [of said semi-rigid core] to a depth terminating near said lower boundary of said writing surface such that a majority of said writing surface extends beyond and generally above said slot."

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CONCLUSION

After entry of the requested amendment, claims 1, 2, 4-7, 10-17, 20-28, and 34-51 are pending the application. In light of this amendment and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable.

The Applicant is available at (404) 245-5718 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the Examination.

The Applicant submits herewith a Fee Transmittal, a Petition for Extension of Time, a Credit Card Payment Form, and a Change of Correspondence Address. The Applicant does not believe any requests for extension of time or other fees are required, beyond those accompanying this paper. If additional requests or extensions are necessary to allow consideration of this paper, such extensions are hereby petitioned-for under 37 C.F.R. § 1.136(a) and any fee required therefore (including fees for the net addition of claims) is hereby authorized to be charged to my credit card, in accordance with the Credit Card Payment Form submitted herewith.

Respectfully submitted,



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CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to (571) 273-8300 at the U.S. Patent and Trademark Office on this Saturday, the Second (2nd) day of September, 2006.


J. Scott Anderson